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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,713	12/29/1999	GREGORY R.J. THATCHER	1995-033-12U	1352

7590 01/16/2002
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EXAMINER
DELACROIX MUIRHEI, CYBILLE

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 01/16/2002

124

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/473,713

Applicant(s)
THATCHER et al.

Examiner
Cybille Delacroix-Muirheid

Art Unit
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov. 5, 2001
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20, 22, 24, 26, 28, and 33-40 is/are pending in the application.
- 4a) Of the above, claim(s) 12, 15, and 26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-40 is/are allowed.
- 6) ☒ Claim(s) 11, 13, 14, 16-20, 22, 24, and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13

- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

The following is responsive to Applicant's amendment received Nov. 5, 2001.

New claims 33-40 are added. No claims are cancelled. Claims 11-20, 22, 24, 26, 28, 33-40 are currently pending.

The previous objection of claim 13 set forth in paragraph 2 of the office action mailed Jul. 5, 2001 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

All previous claims rejections set forth in paragraphs 3-10 of the office action mailed Jul. 5, 2001 **are withdrawn** in view of Applicant's amendment and the remarks contained therein.

Allowable Subject Matter

Claims 33-40 are free from the prior art because the prior art does not disclose or fairly suggest Applicant's claimed methods.

New Ground of Rejection

Claim Rejections - 35 USC § 112

1. Claims 11, 13, 14, 16-20, 22, 24 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, the limitation where substituents E, F1, F2, G1, G2 are "the same or different organic radical" is vague and indefinite. The metes and bounds of this limitation are

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unascertainable and one of ordinary skill in the art would not be readily apprised of the scope of the claimed compound and ultimately the claimed method. In other words, the scope of the invention cannot be determined with a reasonable degree of certainty. Applicant is respectfully requested to amend the claims to recite the organic radicals embraced in the inventive method.

Moreover, in claims 11 and 13, the use of "F1" and "F2" as substituents is vague and indefinite because "F" is commonly used to represent fluorine in chemical formulas and it is not clear whether F1 and F2 are meant to additionally represent fluorine as well as other organic moieties.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 11, 14, 24 and 28 are rejected under 35 U.S.C. 102(a) as being anticipated by Miura 5,905,086.

Miura discloses methods of treating anxiety neurosis or panic disorder comprising administering effective amounts of a composition comprising nicorandil. The compositions may be formulated in tablets, capsules, suspensions, etc. Please see col. 1, line 66 to col. 2, line 44; col. 3, lines 5-22.

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With respect to claim 28, modulation of guanylyl cyclase activity would be inherent since the disclosed compound (nicorandil) anticipates the claimed generic compound.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM

Jan. 14, 2002


Cybille Delacroix-Muirheid
Patent Examiner Group 1600